

REMARKS

The application was filed with claims 1-40. Claims 41-45 were added by preliminary amendment. Claims 39-71 were added by preliminary amendment. Claims 4-8 were amended by preliminary amendment. Claims 4-5 and 41-45 have been canceled herein. New claim 46 has been added herein. Thus, claims 1-3, 6-40, and 46 are pending. Claims 14-19 and 22-40 are currently withdrawn pursuant to a Restriction Requirement. Therefore, claims 1-3, 6-13, 20-21, and 46 are currently under examination.

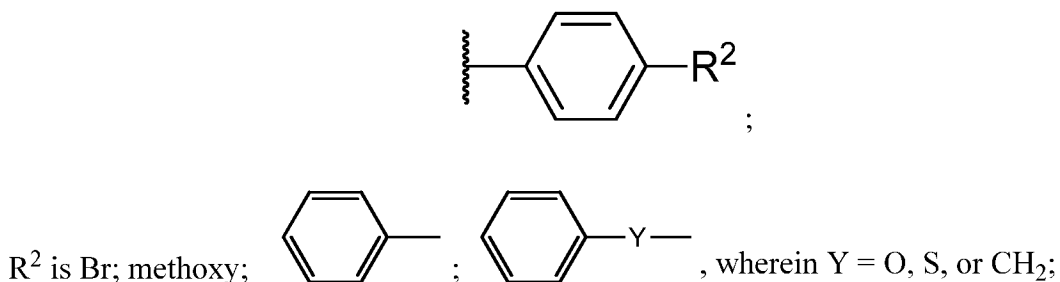
Request for Telephonic Examiner Interview

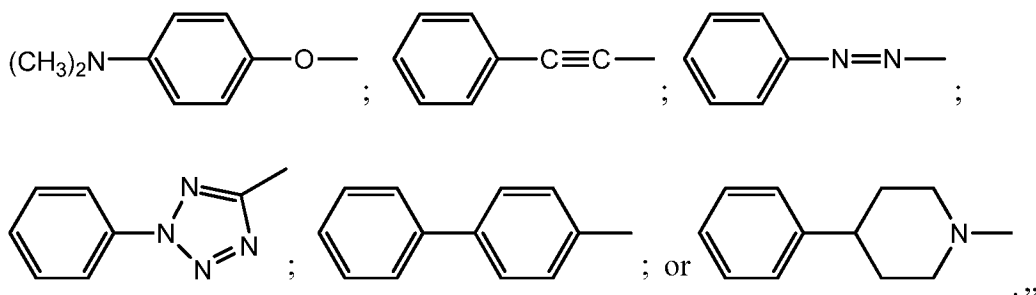
Applicant believes that the instant amendments, arguments, and submissions place the pending claims in condition for allowance. If the Examiner does not agree that the pending claims are allowable, Applicant respectfully requests an opportunity to discuss the reasons supporting patentability in a telephone interview. After review of the Amendments and Remarks set forth herein, and at Examiner's convenience, please contact the undersigned to schedule a teleconference.

To this end, Applicant has enclosed herewith a Form PTOL-413A.

Claim Amendments

Claim 1 has been amended to recite, *inter alia*, "X is $(\text{CH}_2)_n(\text{CH}_2)$, or $\text{CH}=\text{CH}$, wherein $n = 0, 1$, or 2 ; R is a substituted aryl group of the following formula:



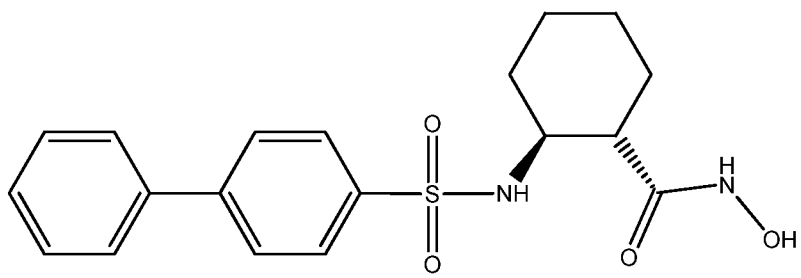


No new matter has been added by this amendment. Support for this amendment can be found throughout the specification and, specifically, at original claim 5.

Claims 6-8 have been amended for dependency only. No new matter has been added. No showing of support is believed necessary.

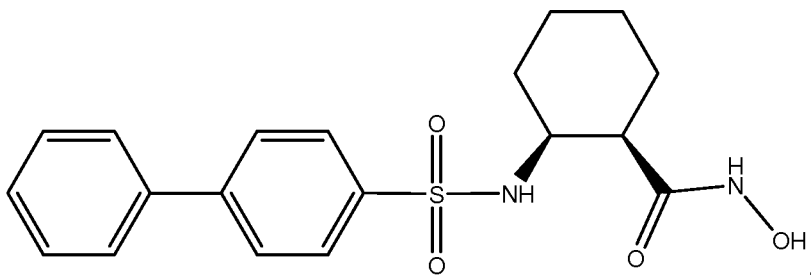
Claims 20, 23, 30, 35, and 39-40 have been amended to recite a compound commensurate with the compound recited in claim 1. No new matter has been added by this amendment. Support for this amendment can be found throughout the specification and, specifically, at original claim 5.

Claims 21 and 25 have been amended to specifically recite the structure from the compound of claim 9:



or a pharmaceutically acceptable salt thereof. No new matter has been added by this amendment. Support for this amendment can be found throughout the specification and, specifically, at original claim 9.

Claim 26 has been amended to specifically recite the structure from the compound of claim 10:

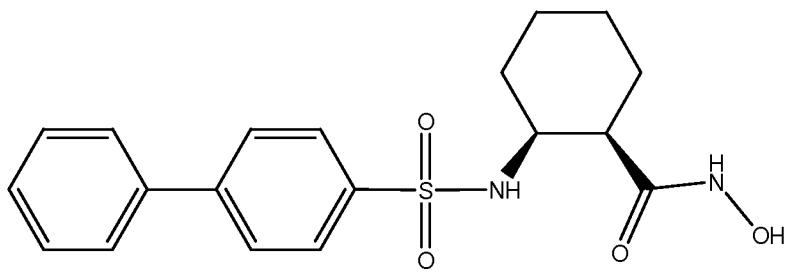


or a pharmaceutically acceptable salt thereof. No new matter has been added by this amendment. Support for this amendment can be found throughout the specification and, specifically, at original claim 10.

Claim 37 has been amended to remove the unnecessary language “of claim 1.” No new matter has been added. No showing of support is believed necessary.

New Claim 46

New claim 46 recites that the composition of claim 20 specifically comprises the compound of claim 10:

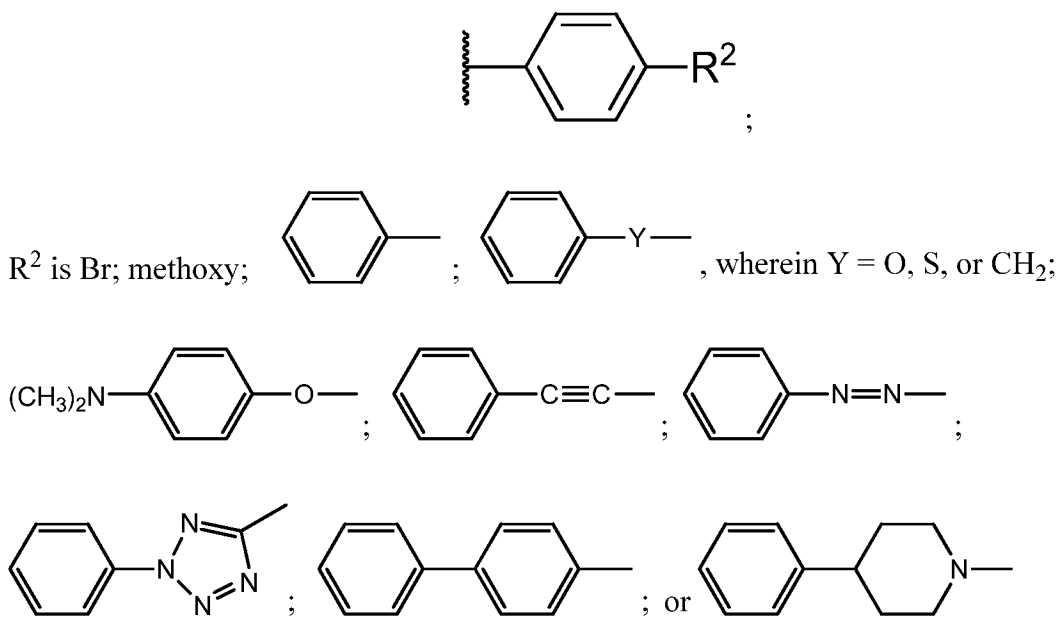


or a pharmaceutically acceptable salt thereof. No new matter has been added. Support can be found throughout the specification and, specifically, at original claim 10.

Claim Rejections under 35 U.S.C. § 102

Claims 1-13, 20-21, and 41-45 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,642,255 to Xue et al. (hereinafter “Xue”). Applicant respectfully disagrees with these rejections with respect to the amended claims.

To anticipate a claim, the cited reference must disclose each and every recited element of the claim. MPEP § 2131 (“A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). Here, Xue fails to disclose each and every recited element of amended claim 1. Specifically, amended claim 1 (as well as all other pending claims, which depend directly or indirectly from claim 1 or otherwise incorporate all of the chemical structural features of the compound recited in claim 1) recites, *inter alia*, that X is $(\text{CH}_2)_n(\text{CH}_2)$, or $\text{CH}=\text{CH}$, wherein $n = 0, 1$, or 2 ; R is a substituted aryl group of the following formula:



In contrast, as admitted by the Office Action, Xue discloses only compound wherein X is $(\text{CH}_2)_n\text{O}$ or $(\text{CH}_2)_n\text{NR}^1$. Thus, because at least this recited element of amended claim 1 is absent from the disclosure of Xue, Xue fails to teach each and every recited element of the pending

claims. As such, Xue cannot anticipate the pending claims, and this rejection must be withdrawn.

Claim Objections

The Office Action has requested that the pending claims be amended to exclude non-elected subject matter. In view of the instant amendments, it is believed that the pending claims now exclude non-elected subject matter and are allowable over the cited references.

Allowability of Dependent Claims 14-19

While compound claims 14-19 have been indicated as withdrawn by the Examiner, it is respectfully asserted that such withdrawal is improper and that characterization of these claims as “method” claims is inaccurate. Specifically, as expressly recited in each claim preamble, these claims are directed to the same statutory class (i.e., compounds) as pending claims 1-3 and 6-13. Indeed, all of claims 14-19 depend from claim 1. In view of the instant amendments to claim 1, it is believed that all of claims 1-3 and 6-13 are allowable. Likewise, as all of claims 14-19 depend from claims 1, these claims are also allowable. Accordingly, Applicant respectfully asserts that compound claims 14-19 should be rejoined and allowed.

Request for Rejoinder of Method Claims

In view of the allowability of at least product claims 1-3, 6-13, 20-21, and 46, Applicant respectfully requests rejoinder of withdrawn method claims 14-19 and 22-40.

The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits.

MPEP § 821.04.

Product claims 1-3 and 6-13, directed to compounds, are allowable. Product claims 20-21 and 46, directed to pharmaceutical compositions, are allowable. Method claims 14-19 and 22-40 include all the limitations of at least one of allowable product claims (e.g., compound claim 1). MPEP § 821.04(b) states that “if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder.” MPEP § 821.04(b) also states that “[p]rocess claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance.” Accordingly, Applicant respectfully asserts that all method claims 14-19 and 22-40 should be rejoined and allowed.

CONCLUSION

In light of the above amendments and remarks, the claims are believed to be allowable, and Applicant respectfully requests notification of same. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of the application to issuance.

As no more than claims are pending after this amendment than were pending prior to this amendment, no additional total claims fees are believed due. Should the Examiner grant Applicant's Request to Rejoin Withdrawn Claims 14-19 and 22-40, additional fees for four independent claims in excess of three would be believed due, as seven independent claims would then be pending after this amendment. If the Examiner grants Applicant's Request, the Commissioner is hereby authorized to charge the amount of \$440.00 (reflecting the fee for four independent claims in excess of three for a small entity) to Deposit Account No. 14-0629.

A three-month shortened statutory period was set for response, nominally ending June 18, 2011. Enclosed herewith is a Request for Extension of Time, thereby extending the period for response to September 18, 2011. This paper is therefore timely. Payment in the amount of \$555.00 (reflecting the fee for the Request for Extension of Time under 37 C.F.R. §1.17(a) for a small entity) is enclosed herewith. The payment is made electronically to be charged to a credit card. No further fee is believed due; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,
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CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence – including any items indicated as attached, enclosed, or included – is being transmitted by EFS-WEB on the date indicated below.

/ D. Brian Shortell /

August 21, 2011

D. Brian Shortell, JD, PhD

Date